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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

016295.0697

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on _____

Signature _____

Typed or printed name Alfonso Juarez

Application Number

09/961,218

Filed

September 21, 2001

First Named Inventor

Michael E. Brown et al.

Art Unit

2145

Examiner

Bhatia, Ajay M.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. Registration number 51,749

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

E. M. Grabski

Signature

Eric M. Grabski

Typed or printed name

(512) 322-2689

Telephone number

March 5, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Michael E. Brown et al.
Serial No.: 09/961,218
Date Filed: September 21, 2001
Group Art Unit: 2145
Confirmation No.: 4097
Examiner: Bhatia, Ajay M.
Title: **SYSTEM AND METHOD FOR NAMING
HOSTS IN A DISTRIBUTED DATA
PROCESSING SYSTEM**

MAIL STOP – AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review (“Request for Review”) is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 (“OG Notice”). Pursuant to the OG Notice, this Request for Review is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the Application in light of the remarks set forth below.

REMARKS

Applicants contend that the rejections of Claims 1-12 and 14-33 on prior art grounds contain clear legal and factual deficiencies, as described below. In a Final Office Action dated October 01, 2006:

- Claims 1-4, 6, 9-11, 16-18, and 22 were rejected as under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0161868 to Paul et al. ("*Paul*") in view of U.S. Patent No. 5,974,547 to Klimenko ("*Klimenko*") (see Final Office Action, Page 3); and
- Claims 5, 7, 8, 12, 14, 15, 19, and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Paul* in view of *Klimenko* in further view of U.S. Patent No. 5,864,656 to Park ("*Park*") (see Final Office Action, Page 7).

Applicants request a finding that these rejections are improper and allowance of these claims for at least the following reasons. The following discussion focuses on Claim 1, as Claim 1 is representative of the other pending independent claims (Claims 9 and 16).

In the Response to Final Office Action, Applicants explain limitation-by-limitation that the passages of the prior art cited by the Examiner clearly do not disclose various limitations of Claim 1. In some instances, the portions of *Paul* and *Klimenko* cited by the Examiner disclosed nothing remotely similar to the relevant limitation of Claim 1.

In response to Applicants' limitation-by-limitation argument, the Examiner opines in the Advisory Action mailed February 14, 2007:

It appears from reading applicant's representative's remarks that he is well aware of the teachings of the prior art and that the prior art teaches the features disclosed in the claims, but has elected to read only the portion of the reference cite[d] with out context. Therefore examiner suggest applicant's representative's read the entire prior cited and submit amendments to overcome the prior art to further prosecution of the case." (Advisory Action, Page 2).

Applicants submit that it is inappropriate for the Examiner to speculate that Applicants' representative knows Applicants' claims to be unpatentable yet intentionally elects to read the prior art out of context in order to obtain allowance. It is the responsibility of the Examiner, not Applicants or its representatives, to identify the portions of the cited references that allegedly disclose the limitations of Applicants' claims.

According to the M.P.E.P.:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. (M.P.E.P. § 2142, page 2100-125)

In addition, 37 C.F.R. § 1.104 explains that the Examiner is obligated to designate the particular part of a reference relied on for an obviousness rejection, and to clearly explain the relevance of such designated part:

In rejecting claims for want of novelty or obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

37 C.F.R. § 1.104 (emphasis added).

In view of these and other statutory and M.P.E.P. standards, Applicants believe it is clear that the Examiner must indicate the particular portions of the cited references that allegedly teach Applicants' claim limitations -- and that if the cited portions do not teach Applicants' claim limitations, then there can be no *prima facie* case of obviousness.

Thus, Applicants refer the board to Applicants' Response to Final Office Action, and specifically to Applicants' limitation-by-limitation analysis comparing the limitations of Claim 1 to the passages of the prior art cited by the Examiner. The analysis explains that the prior art passages cited by the Examiner do not disclose at least the following limitations of Claim 1:

- **receiving a unique identifier (UID) at a cluster controller from each of a plurality of hosts in communication with the cluster controller, while at least one of the plurality of hosts is executing in a pre boot execution environment;**
- **in response to receiving the UIDs, causing the plurality of hosts to produce ready signals;**
- **in response to receiving the user input from a first host, associating a first host name with the UID for the first host;**
- **after associating the first host name with the UID for the first host, causing the first host to produce a completion signal;**

- **repeating the operations of receiving replies from hosts, associating host names with UIDs, and causing hosts to produce completion signals, until each of the plurality of hosts has been named, such that the user input dictates the order in which host names are assigned to the multiple hosts;**
and
- **receiving user input from a first host among the plurality of hosts, the user input comprising notification of the insertion of a disk within the first host;**

For at least these reasons, and the reasons set forth in Applicants' Response to Final Office Action, Applicants submit that the rejection of Claim 1 under *Paul* and *Klimenko* is improper. Therefore, Applicants request allowance of Claim 1, as well as Claims 2-8 that depend from Claim 1. In addition, for reasons analogous to those provided above, Applicants request allowance of independent Claims 9 and 16, as well as Claims 10-12, 14-15, and 17-21 that depend therefrom.

CONCLUSION

Applicants submit these Arguments in Support of Pre-Appeal Brief Request for Review along with a Notice of Appeal.

Applicants believe there are no fees due at this time (fees for the Notice of Appeal and a two month Extension of Time are discussed in the Notice of Appeal). However, the Commissioner is hereby authorized to charge any additional fees necessary or credit any overpayments to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2689.

Respectfully submitted,
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Attorney for Applicants

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Date: March 5, 2007

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